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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,892	08/29/2001	Eric D. Anderson	500247.03	2384

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EXAMINER

ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/09/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,892

Applicant(s)

ANDERSON, ERIC D.

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 30 – 36 are presented for examination.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 30, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson et al. (6654787) (hereinafter Aronson).
3. Referencing claim 30, Dillon teaches a computer-implemented method for one of a plurality of designated recipients of an Email communication to receive the Email, comprising:
 4. receiving an Email communication notification from the server that references the single copy of the Email communication, the Email communication notification distinct from the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65);
 5. requesting from the server the referenced Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65), but does not specifically teach storing a single copy of the Email communication designated for the plurality of recipients on a server;

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6. receiving from the server a copy of the requested Email communication. Aronson teaches storing a single copy of the Email communication designated for the plurality of recipients on a server, (e.g. col. 10, line 65 – col. 11, line 6);

7. receiving from the server a copy of the requested Email communication, (e.g. col. 8, line 30 – col. 9, line 16). It would have been obvious to one skilled in the art at the time the invention was made to combine Aronson with Dillon because it would be more efficient to conserve space with having one central location, having users reference the single copy of the email then having multiple copies of an email taking up substantial space. Furthermore, it is more convenient for a user to have a local copy of an Email so incase the user is off line and wants to modify the local copy of the Email, the user could with out modifying the original Email that could be used as an archived document for reference if desired.

8. As per claim 34, Dillon teaches the Email communication received from the server is encrypted using a public encryption key for the one of the plurality of designated recipients, and including retrieving a private encryption key for the one of the plurality of designated recipients to decrypt the Email communication, (e.g. col. 9, line 60 – col. 10, line 15).

9. As per claim 35, Dillon teaches wherein the method is performed by a receiving computer lacking sufficient permanent storage to store the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65).

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10. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Arnold (6275848).

11. Referencing claim 31, Dillon and Aronson do not specifically teach when access to the Email communication is no longer desired, indicating to the server to delete the Email communication, so that the server deletes the single stored copy of the Email communication after receiving indications from all recipients to delete the Email communication. Arnold teaches when access to the Email communication is no longer desired, indicating to the server to delete the Email communication, so that the server deletes the single stored copy of the Email communication after receiving indications from all recipients to delete the Email communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with the combine system of Dillon and Aronson because of similar reasons stated above.

12. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Arnold (6275848) with what is well known in the art.

13. Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known"

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in the first Office action, i.e. storing the Email communication locally such that the local stored Email communication is preserved even when the server deletes the single stored copy, are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). The rejection is repeated for the Applicant's convenience.

14. As per claim 33, Dillon does not specifically teach storing the Email communication locally such that the local stored Email communication is preserved even when the server deletes the single stored copy.

15. Official Notice is taken that it was a common practice to storing the Email communication locally such that the local stored Email communication is preserved even when the server deletes the single stored copy at the time the instant invention was made.

16. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Dillon because of similar reasons stated above. Furthermore, if the user saves the Email locally on one computer and disconnects from the network and then logs in on a different computer and deletes the Email on the server there is no way for the Email to be deleted on the first computer. Also if the user were to save the Email on a floppy disk and then delete the Email from the server, the server cannot delete the Email on the floppy disk, especially if the floppy disk is removed.

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17. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Arnold (6275848) in further view of Devine et al. (6385644) (hereinafter Devine).

18. As per claim 32, Dillon, Aronson and Arnold do not specifically teach after the receiving of the Email communication notification, storing the Email communication notification locally;

19. after the indicating to the server to delete the Email communication, deleting the stored Email communication notification even if all recipients have not indicated to delete the Email communication. Devine teaches after the receiving of the Email communication notification, storing the Email communication notification locally, (e.g. col. 12, lines 40 – 55);

20. after the indicating to the server to delete the Email communication, deleting the stored Email communication notification even if all recipients have not indicated to delete the Email communication, (e.g. col. 12, lines 40 – 55). It would have been obvious to one skilled in the art at the time the invention was made to combine Devine with the combine system of Dillon, Aronson and Arnold because of similar reasons stated above and further, if a user has a personal records of Email communication notifications it could prevent loss of information if the server were to break down and/or crash, (i.e. redundancy).

21. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Aronson (6654787) in further view of Homan et al. (6317485).

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22. Referencing claim 36, Dillon and Aronson do not specifically teach wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server. Homan teaches wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server, (e.g. col. 6, lines 28 – 49 & col. 7, lines 1 – 44). It would have been obvious to one skilled in the art at the time the invention was made to combine Homan with the combine system of Dillon and Aronson because of similar reasons stated above and further it would be more efficient for a system to utilize a type of preference setting to classify or possibly utilize different types of Email communication notifications. This will diversify the way a user may receive notifications about incoming Email.

Conclusion

23. Applicant's arguments with respect to claims 30 – 36 have been considered but are moot in view of the new ground(s) of rejection.

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

25. a. Gifford et al. U.S. Patent No. 6549612 discloses Unified communication services via e-mail.

26. b. Yeager U.S. Patent No. 6167402 discloses High performance message store.

27. c. Birrell et al. U.S. Patent No. 6009462 discloses Replacing large bit component of electronic mail (e-mail) message with hot-link in distributed computer system.
28. d. Lambert et al. U.S. Patent No. 6038601 discloses Method and apparatus for storing and delivering documents on the internet.
29. e. Beyda et al. U.S. Patent No. 6275850 discloses Method and system for management of message attachments.

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

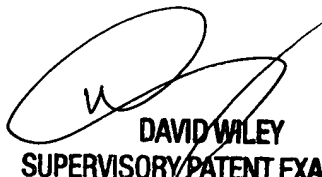
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De



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SUPERVISORY PATENT EXAMINER
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